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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,338	01/14/2000	John Calabria	174-831-999	6846
23517	7590	07/28/2004	EXAMINER	
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP			LEE, EDMUND H	
3000 K STREET, NW			ART UNIT	PAPER NUMBER
BOX IP			1732	
WASHINGTON, DC 20007				

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/482,338	CALABRIA ET AL.
	<b>Examiner</b> EDMUND H. LEE	<b>Art Unit</b> 1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-57 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-57 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

1. It should be mentioned that the species election set forth in the previous office actions have been withdrawn by the examiner. An examination of Claims 1-57 is set forth below.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6042768. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well-known in the molding art to cover less than or more than half of a preform and then cover the remaining portion of the preform in a subsequent molding step. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cover less than or more than the core of '768 by the process of '768 in order to provide a more uniform layer.

4. Claims 34,35,38,39,42,43,46,47, and 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the layer" (each of the listed claims) lacks antecedent basis in the claim.

Clarification and/or correction is required.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 14, 15,17,18,20,21,22, 28, 53, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al (USPN 5006297). Brown et al teach the claimed process as evident at col 6, Ins 29-32; col 7, Ins 1-13; and figs 1-2. In regard to claims 174-18, such limitations are inherent in order to form a golf ball having a centered core.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1732

8. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach the specific state of gel for the polyurethane; and the aligning steps of claim 19. In regard to the specific state of gel for the polyurethane, viscosity is well-known in the molding art as an important molding parameter and the desired viscosity would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed viscosity is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use PU having the claimed viscosity in the process of Brown et al in order to ensure proper center of the core. In regard to the aligning steps of claim 19, such are well-known in the molding art in order to ensure proper centering of a preform within a molding material. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the claimed aligning steps into the process of Brown et al in order to ensure that the core of Brown et al is properly centered.

9. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). In regard to claim 23, Brown et al teach the basic claimed process except allowing the first portion of pu to partially cure to a state of gel between 2000 and 30000 cps; and allowing the second portion of pu to partially cure to a state of gel between 2000 and 30000 cps. In regard to allowing the fist and second portions to partially cure to the claimed viscosity, viscosity is well-known in the molding

art as an important molding parameter and the desired viscosity would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed viscosity is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use PU having the claimed viscosity in the process of Brown et al in order to ensure proper center of the core. In regard to claim 24, Brown et al do not teach the claimed aligning steps, however such are well-known in the molding art in order to ensure proper centering of a preform within a molding material. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the claimed aligning steps into the process of Brown et al in order to ensure that the core of Brown et al is properly centered.

10. Claims 25-27 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). In regard to claim 25, Brown et al teach the basic claimed process except placing the second portion into a second cavity at a time subsequent to the placing of the first portion into the first cavity. It should be mentioned that Brown et al teach placing pu into each of the cavities (col 7, Ins 1-5). Sequential placement of material into multiple cavities is well-known in the molding art in order to reduce mold equipment complexity and to better control the condition of the material. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the second portion of Brown et al into the cavity after the placement of the first portion in order to better control the curing of the second

portion. In regard to claims 26-27, such are inherently taught by Brown et al (col 6, lns 29-32; col 7, lns 1-13; and figs 1-2). In regard to claims 49-52, Brown et al do not teach molding a solid core; a thermoset layer; a latex layer; and preheating the mold halves to the claimed temperature. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al. In regard to preheating the mold halves to the claimed temperature, such is well-known in the molding in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold halves of Brown et al to within the claimed range in order to reduce cycle time without harming the quality of the material and the molded golf ball.

11. Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach molding a solid core; a thermoset layer; a latex layer; and preheating the mold halves to the claimed temperature. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al. In regard to preheating the mold halves to the claimed temperature, such is well-known in the molding in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold halves of Brown et al to within the claimed range in order to reduce cycle time without harming the quality of the material and the molded golf ball.

12. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach molding a solid core; a thermoset layer; a latex layer; and preheating the mold halves to the claimed temperature. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al. In regard to preheating the mold halves to the claimed temperature, such is well-known in the molding in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold halves of Brown et al to within the claimed range in order to reduce cycle time without harming the quality of the material and the molded golf ball.

13. Claims 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach molding a solid core; a thermoset layer; a latex layer; and preheating the mold halves to the claimed temperature. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al. In regard to preheating the mold halves to the claimed temperature, such is well-known in the molding in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold halves of Brown et al to within the claimed range in order to reduce cycle time without harming the quality of the material and the molded golf ball.

14. Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach molding a solid core; a thermoset layer; a latex layer; and preheating the mold halves to the claimed temperature. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al. In regard to preheating the mold halves to the claimed temperature, such is well-known in the molding in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold halves of Brown et al to within the claimed range in order to reduce cycle time without harming the quality of the material and the molded golf ball.

15. Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach molding a solid core; a thermoset layer; a latex layer; and preheating the mold halves to the claimed temperature. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al. In regard to preheating the mold halves to the claimed temperature, such is well-known in the molding in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold halves of Brown et al to within the claimed range in order to reduce cycle time without harming the quality of the material and the molded golf ball.

16. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN 5006297). The above teachings of Brown et al are incorporated hereinafter. Brown et al do not teach molding a solid core; a thermoset layer; and a latex layer. In regard to molding a solid core, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a solid core for the golf ball of Brown et al in order to provide better play characteristics. In regard to a thermoset layer, it is well-known in the molding art to use a primer layer in order to better bond materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoset as the layer of Brown et al in order to better bond the core to the thermoset pu of Brown et al. In regard to a latex layer, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, latex primer layers are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a latex primer layer in the process of Brown et al in order to better bond the core to the pu cover layer of Brown et al.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE  
Primary Examiner  
Art Unit 1732

EHL

  
2/26/04